

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REXFORD H. BRADT

Appeal No. 1998-0395
Application No. 08/333,503

ON BRIEF

Before ABRAMS, MCQUADE, and JENNIFER D. BAHR, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 5, 6, 9, 11, 12, 14, 15, 21-23 and 25. In response to the appellant's arguments in the Brief, the examiner withdrew the rejection of claims 11 and 12 (Answer, page 3), leaving before us on appeal claims 1-3, 5, 6, 9, 14, 15, 21-23 and 25.

We REVERSE.

BACKGROUND

The appellant's invention relates to a process of operating an injection molding machine. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Molbert	4,031,176	Jun. 21, 1977
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Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1-3, 5, 9, 14, 15, 21-23 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Molbert.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) for the appellant's arguments thereagainst.

¹ Claim 6 was included in this rejection in the second office action (Paper No. 4), but was not listed in the final rejection (Paper No. 6) or in the Answer (Paper No. 11). We therefore consider it as having been withdrawn by the examiner.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, the applied prior art references, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The Rejection of Claim 6 Under 35 U.S.C. § 112, First Paragraph

In an amendment in response to the second office action, the appellant added "rigid" to claim 6 to modify the description of the three parts of the mold cavity. The examiner took issue with this, pointing out that the term was not present in the specification, and rejecting the claim under the first paragraph of Section 112.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Our review of the appellant's disclosure confirmed the examiner's conclusion that the term "rigid" is not used to describe the movable parts that enclose the

mold cavity. Therefore, explicit support for the disputed term is not present. However, from our perspective, one of ordinary skill in the art would have understood from the specification that "rigid" parts not only typically are used in mold components, but probably would have been the first to come to mind. This is buttressed by the statements from Molbert to which the appellant has referred.

We therefore will not sustain the rejection of claim 6.

The Rejection Under 35 U.S.C. § 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Independent claim 1 is directed to operating an injection molding machine to

manufacture, "in a mold cavity," a substantially weld line free plastic part. Among the steps in the method is "reducing the volume of the cavity along with the volume of the material therein sufficiently to produce an essentially foam-free part." We do not agree with the examiner that this is taught by Molbert. The reference discloses a mold cavity (5) which is in the shape of the part to be formed. However, the material from which the part is formed is not injected directly into the mold, but into a membrane (23) that ultimately is expanded by the pressure of injection into the shape of the mold. In order to accomplish the objectives of the Molbert invention, this expansion will be opposed by a fluid injected into the space between the membrane and the walls of the cavity. Even if one considers that Molbert injects a measured quantity of foamable plastic material into the cavity, neither the volume of the cavity nor the volume of the material therein is reduced in the course of the procedure, as is required by the appellant's claim 1. The only reduction that occurs is in the volume of the space between the membrane and the walls of the cavity, and that is because the volume of mold material is increased, rather than reduced.

It therefore is our conclusion that the teachings of Molbert fail to establish a prima facie case of obviousness with respect to the subject matter recited in the appellant's claim 1. The rejection of claim 1 is not sustained nor, it follows, is the like rejection of claims 2, 3, 14 and 15, which depend therefrom.

Independent claim 21 recites a process wherein a mold is pre-closed after molding a prior part to form an enclosing compartment, whereafter the compartment is "explosively

filled" with molding material and the material is "rapidly compacted." In Molbert, while the material would appear to be compacted as it forces the membrane to expand, the enclosing compartment is not compacted at any point in the method. Thus, a prima facie case of obviousness also is lacking here, and we will not sustain the rejection of claim 21 or dependent claims 22 and 23.

We reach the same conclusion with regard to independent claim 25 and dependent claims 5 and 9. Claim 25 sets forth the steps of injecting a measured quantity of foamable plastic material into a mold cavity and then reducing the volume of the cavity along with the volume of the material therein. As we explained above with regard to claim 1, this is not taught by Molbert.

CONCLUSION

The rejection of claim 6 under 35 U.S.C. § 112, first paragraph, is not sustained.

The rejection of claims 1-3, 5, 9, 14, 15, 21-23 and 25 under 35 U.S.C. § 103 is not sustained.

The decision of the examiner is reversed.

Reversed

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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APPEAL NO. 98-0395 - JUDGE ABRAMS
APPLICATION NO. 08/333503

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DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 22 Aug 01

FINAL TYPED: